

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 12-18 are pending in this application. Claim 18 is added by the present response. Claims 12, 13, and 17 were rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 6,181,938 to Salmela et al. (herein “Salmela”) in view of U.S. Patent No. 6,073,035 to Witter. Claims 15 and 16 were rejected under 35 U.S.C. 103(a) as unpatentable over Salmela and Witter in further view of U.S. Patent No. 6,421,539 to Jeong.

Addressing first the rejection of claims 12, 23, and 17 under 35 U.S.C. § 103(a) as unpatentable over Salmela in view of Witter, that rejection is traversed by the present response.

Initially, applicants submit the basis for the outstanding rejection has not at all considered the remarks filed August 28, 2006 distinguishing the claims as written over the applied art. Those remarks are repeated below but as an initial summary applicants previously commented that no combination of teachings of Salmela and Witter disclosed or suggested controlling “*on-off of a switch* provided between a power supply and the receiver” (Emphasis added). The outstanding Office Action has not pointed to any element that discloses such an “on-off [control of a switch]” and has not addressed any of the numerous comments previously presented and repeated below as to how such a feature distinguishes over the applied art. In that respect the basis for the outstanding rejection has not even addressed on what basis it is proper to ignore that positively recited claim limitation and not establish a proper *prima facie* case of obviousness as required under M.P.E.P. § 2143.

Applicants also provide additional comments below that one of ordinary skill in the art would not even combine the teachings of Witter and Salmela as suggested in the Office Action.

Now in further detail, independent claim 12 recites the controller disables the receiver “by controlling *on-off of a switch* provided between a power supply and the receiver”, see for example switches 22, 24, 26, and 30 in Figs. 1A and 1B in the present specification as non-limiting examples.

Applicants’ disclosure describes a non-limiting example of the claimed features with reference to Figures 1 and 2. In the example, a location registration request signal is transmitted by a mobile station to a base station (step S118). An acknowledge signal is transmitted by the base station when the location registration request signal is received by the base station. Accordingly, the mobile station waits for the acknowledge signal from the base station (step S120). If the acknowledge signal is not received within a predetermined period of time, the power supply to the receiving section of the mobile station is suspended (steps S120 and S122) for a prescribed duration. Thereafter, the power supply is restored to the receiving section and another location registration request signal is transmitted (step S125).<sup>1</sup> Thus, in order to conserve power, the mobile station suspends power to the receiving section and disables transmission of the location registration request signal. As stated by applicants’ disclosure:

As described above, the mobile station according to the present invention turns off the power supply to the receiving section or prohibits the action of the receiving section for a predetermined period of time when the acknowledge signal is not received within a predetermined period after the location registration request signal is transmitted. Thus, it is enabled to save the power by eliminating the situation of the prior art in which the mobile station continues to transmit the location registration request signals [while] waiting for the acknowledge signal when the acknowledge signal is not received.<sup>2</sup>

First, applicants note the basis for the outstanding rejection appears to recognize that Salmela does not disclose or suggest the claimed controller. To overcome those deficiencies

---

<sup>1</sup> See Applicants’ specification, page 10, line 14 – page 11, line 23.

<sup>2</sup> See Applicants’ specification, page 15, line 23 – page 16, line 1.

in Salmela the outstanding Office Action cites Witter. However, no combination of teachings of Salmela and Witter fully meets all of the claimed limitations or would have been suggested to one of ordinary skill in the art.

First, applicants note that in Witter when a search signal cannot be received from a base station in a standby mode, a receiving unit and a control unit are moved to the sleeping mode. Salmela itself has a contrary operation as in Witter and thus would not be properly combinable with Witter. More specifically, in contrast to Witter, Salmela relates to a position registration control that is a process after the standby mode. Thereby, Witter and Salmela are directed to different processes in point of time, and there would have been no suggestion to one of ordinary skill in the art to combine such unrelated teachings.

Further, the claims clearly positively recite features that are not taught or suggested by the combination of teachings of Salmela and Witter.

Specifically, the claims positively recite that the receiver is disabled “by controlling on-off of a switch provided between a power supply and the receiver”. Salmela and Witter clearly do not teach or suggest such a feature.

Witter discloses being able to completely power down a CPU, which would prevent any operation of a receiver, but thereby in Witter many other elements within the device would also be powered down, rather than being able to merely selectively power down a receiver to reduce power consumption such as in the present invention.

That is, Witter merely recites that transmission is disabled by entering a sleeping mode. As discussed above, in the claimed invention the transmission is intentionally disabled by on-off control of a switch. In that respect the claims clearly differ from Witter.

In the claims the receiver is selectively disabled by controlling on-off of a switch provided between a power supply and the receiver. Thus, in the claimed invention only the receiver needs to be powered down. Witter does not have such a structure because in Witter

a CPU is completely powered down. Further, Witter could not realize an operation as in the claimed invention because in Witter the powering down of the CPU will not allow any selective disabling of a receiver. As a result Witter would not and could not even have been modified to meet the claimed limitations of providing a switch provided between a power supply and a receiver to selectively disable the receiver.

Thereby, in Witter no transmission or reception can take place after the CPU is powered down. In contrast to Witter, in the claimed operation the receiver can be selectively disabled intentionally to save power.

In addressing the above-noted feature directed to controlling on-off of a switch, the outstanding Office Action on page 3 states:

The combination of Salmela et al. and Witter does not specifically teach a switch provided between a power supply and the receiver. However, the preceding limitation has been well known in the art. It would have been obvious to one having ordinary skill in the art, at the time of the invention, to provide a switch between the power supply and the receiver to control power supplying to the receiver.

The above-noted basis for the outstanding rejection is improper in several aspects.

As noted in M.P.E.P. § 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must each or suggest all of the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants' disclosure.

The above-noted basis for the outstanding rejection has *not met any* of the three criteria noted above for a proper case of obviousness.

First, clearly neither reference to Winter or Salmela discloses or suggests being modified to control on-off of a switch between a power supply and a receiver. The above-noted statement that “the preceding limitation has been well known in the art” is not understood. Clearly no art has been cited to disclose a switch provided between a power supply and a receiver as claimed. The basis for the outstanding rejection appears to be noting that a switch is known, but the claims do not merely recite a switch without any location or context thereof. Clearly the basis for the outstanding rejection is not fully considering all of the claimed features.

Moreover, applicants note clearly no cited art or any basis has been made to indicate that utilizing a switch as claimed in any of the prior art would provide any benefit or expectation of success.

Moreover, the prior art simply does not teach or suggest the claimed switch.

In such ways, the basis for the outstanding rejection is clearly improper in disregarding the claim limitations.

In view of these foregoing comments, independent claim 12, and the claims dependent therefrom, are believed to clearly distinguish over Salmela in view of Witter.

Addressing now the rejection of claims 15 and 16 under 35 U.S.C. § 103(a) as unpatentable over Salmela in view of Witter and in further view of Jeong, that rejection is further traversed by the present response.

First, applicants note the deficiencies of the combination of teachings of Salmela in view of Witter discussed above are not cured by the teachings in Jeong.

Moreover, applicants submit Jeong does not even address the features recited in further dependent claims 15 and 16, and thus Jeong does not cure the recognized deficiencies of Salmela in view of Witter with respect to claims 15 and 16.

The outstanding Office Action relies upon Jeong to disclose “means for acquiring a second base station” as recited in claim 15. Applicants respectfully submit, however, that Jeong does not disclose that claimed feature.

With features as recited in claim 15 an operation for acquiring a second base station starts when a receiver does not receive an acknowledge signal within a predetermined time period. In contrast to that claimed feature, in Jeong a cellular system starts an operation for acquiring a second base station based on an intensity of an electric field received by the cellular system. As a result, motivation for starting an operation of acquiring a second base station differs between the claimed invention and the teachings in Jeong.

Jeong merely discloses performing a usual handoff. Jeong describes acquiring a base station to which a connection is to be established based on intensity of an electric field received by the cellular system. In other words, in Jeong the intensity of the electric field of a first base station received by the cellular system and the intensity of the electric field of a second base station received by the cellular system are compared, and a connection is established with the base station having the electric field with the greater intensity. Therefore, with the system in Jeong connection may be reestablished with the base station a cellular system is currently connected to.

Such a disclosure from Jeong differs from the claimed invention in which a handoff could be performed on the basis of time period. Further, Jeong does not disclose or suggest the feature that connection is established with a second base station, which differs from a first base station, when a receiver does not receive an acknowledged signal within a predetermined time period.

That is, in claim 15 connection is established with a different second base station when a receiver does not receive an acknowledgement signal within a predetermined time period from a first base station. Jeong does not teach or suggest any similar feature.

Thereby, Jeong does not cure the recognized deficiencies of Salmela in view of Witter with respect to features recited in claims 15 and 16.

Thereby, applicants respectfully submit claims 15 and 16 even further distinguish over the combination of teachings of Salmela in view of Witter and further in view of Jeong.

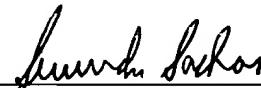
The present response also adds new independent claim 18 for examination, which is believed to also distinguish over the applied art. In that respect independent claim 18 corresponds to independent claim 17 with the additional feature from allowable claim 14 that "the first time period is increased stepwise as time elapses". Thereby, new independent claim 18 is also believed to be allowable.

In view of the present response applicants respectfully submit that the claims as written distinguish over the applied art.

As no other issues are pending in this application, it is respectfully submitted that the present application is now in condition for allowance, and it is hereby respectfully requested that this case be passed to issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



---

Eckhard H. Kuesters  
Attorney of Record  
Registration No. 28,870

Surinder Sachar  
Registration No. 34,423

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 03/06)